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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mai-Ian Tomsen, et al.	Attorney Docket No.: 50588/10
Application No.: 09/748,080	Group Art Unit: 2623
Filed: December 22, 2000	Confirmation No. 3248
For: SYSTEM AND METHOD FOR UNPROMPTED, CONTEXT-SENSITIVE QUERYING DURING A TELEVISION BROADCAST	Examiner: Dominic D. Saltarelli

PRE-APPEAL BRIEF REQUEST FOR REVIEW

TO THE COMMISSIONER FOR PATENTS:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, Applicants request review of the rejection of claims 1, 5, 6, 11-31, 35, 36, and 41-61 in the above-referenced application. As set forth in detail below, clear errors have been made during examination and essential elements required to establish a *prima facie* rejection of the pending independent claims are missing.

In the Office Action dated January 24, 2007 (the "Office Action"), each of the pending independent claims—claims 1, 31, and 61—were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,748,375 issued to Wong et al. ("Wong") in view of U.S. Patent No. 6,184,877 issued to Dodson et al. ("Dodson") and in further view of U.S. Patent No. 5,991,799 issued to Yen et al. ("Yen").

Claim 1 recites a method wherein user activation of a specifically-designated button on a remote control device results in the display of supplemental content related to the programming being viewed on an interactive television system without further user input. Claim 31 recites a system including a remote control device with a specifically-designated button for requesting supplemental content. Like the method

recited in claim 1, the system of claim 31 allows for a user to activate the specifically-designated button and, without further user input, view a display of supplemental content related to the television program currently being watched. Similarly, claim 61 recites a machine-readable medium comprising program code that, upon detection of a single button press on a remote control, retrieves and displays supplemental content without further user input. None of the cited references, whether considered alone or in combination, contain disclosure sufficient to meet these limitations. Indeed, the combined disclosures of each of the cited references would not disclose or suggest a system that displays supplemental content in response to a single user command without further user input.

To illustrate, Wong discloses a system that utilizes the closed-captioning text from a television broadcast to perform keyword searches on the Internet for content related to the broadcast. Wong does not, however, allow a user to view supplemental content by pressing a single button without requiring further user input. Instead, Wong discloses continually performing keyword searches and displaying the search results in a scrolling list that allows a user to select a desired search result from among the scrolling results. Wong's scrolling list requires multiple user steps before receiving and viewing supplemental information and, furthermore, provides a constant distraction to the programming being viewed.

Dodson discloses a system for generating context-sensitive information during a television broadcast. Dodson does disclose providing a specifically-designated search button. However, the Dodson search button results in the display of a list of automatically-generated search terms and then allows the user to make modifications to

the search terms prior to actually transmitting the search. At the very least, a user would have to view the generated search terms and approve of them before receiving supplemental content. Applicants' claimed invention, by contrast, allows a user to simply push a button and immediately receive supplemental content without further input being required.

The Examiner apparently agrees that the Wong/Dodson combination fails to disclose or suggest this claimed combination of features. *See* Office Action at page 4, last paragraph ("Wong and Dodson fail to disclose displaying the supplemental content on the interactive television system (without further user input after receiving the user command to find supplemental content)."). The Examiner therefore cites a new reference, Yen, for meeting these missing elements. However, not only does Yen wholly fail to adequately supplement the Wong/Dodson combination, it actually **teaches against** Applicants' claimed invention.

Yen discloses a system for receiving information from multiple sources and presenting the received information to a user. The Yen system includes "background" and "foreground" elements. The background element determines whether information is likely to be interesting to a user and, if so, causes the foreground element to become active to engage the user to select and/or view the new information. However, Yen does not disclose or suggest displaying supplemental content in response to a user command and without further user input. In fact, the foreground of the Yen system is activated automatically, rather than in response to a user command. *See, e.g.,* col. 3, lines 9-26. The system receives information from passive sources and "determines whether information from those sources is likely to be interesting to the recipient." Col.

3, lines 11-13. When the background comes across information that is determined as likely to be of interest to the viewer, "it causes the foreground to become active and engage the recipient to select and view that new information." Col. 3, lines 21-22. Accordingly, the Yen system will intermittently interrupt a viewer with information that may or may not be useful or interesting to the viewer.

This is in direct contradiction to the teachings associated with Applicants' claimed invention. The claimed invention is aimed at minimizing viewing interruptions and minimizing user steps required in order to receive supplemental information relating to television programming. Yen's teachings are not only entirely unsupportive of these goals, its teachings are actually contrary to them. To illustrate, the Yen system first requires a user to provide preference information such that the system can attempt to select information that is likely to be of interest to the user. *See, e.g.*, col. 9, line 66 through col. 10, line 4. Then, since the Yen system is user-specific, presumably a user would have to select a profile before each viewing session in order to receive the appropriate content according to the preference information entered by that user. Even after completing each of these preliminary steps, a user of the Yen system would be continually interrupted by the background element without ever receiving an indication from the user that he or she has an interest in viewing supplemental information. Since the Yen system attempts to predict whether the user will have interest in the supplemental information, not only will the information often be a disruption, but it will also inevitably sometimes contain information that is of no interest to the user. Yen therefore not only fails to minimize user steps, due to the extensive set-up process required in order to allow the system to predict what supplemental content might be of

interest to a viewer, but Yen also fails to minimize interruptions. Indeed, Yen relies upon—even demands—viewing interruptions to present supplemental information. Despite all of the preliminary user steps required, Yen does not call upon the user to provide input at the one and only time Applicants' invention calls for input. Consideration of Yen would therefore not provide any teaching, suggestion, or motivation that would lead a person of ordinary skill in the art any closer to the invention recited in independent claims 1, 31, and 61. In fact, by incorporating the Yen teachings into the Wong/Dodson combination, one of ordinary skill in the art would be even further from Applicants' claimed invention than with Wong and Dodson alone.

For at least the foregoing reasons, Applicants submit that claims 1, 31, and 61 are allowable over the art that has been cited and applied by the Examiner. For at least the same reasons, each of the pending dependent claims are also patentably distinct. Applicants therefore respectfully request withdrawal of the pending rejections and allowance of the application.

Respectfully submitted,

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